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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,120	03/17/2000	Daphne Preuss	ARCD:P-01912US7	5601

24573 7590 05/24/2004

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EXAMINER

STRZELECKA, TERESA E

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/531,120

## Applicant(s)

PREUSS ET AL.

## Examiner

Teresa E Strzelecka

## Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-127,133,141-144 and 147-231 is/are pending in the application.
- 4a) Of the above claim(s) 1-127 and 147-231 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 141-144 is/are allowed.
- 6) ☒ Claim(s) 133 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/13/01, 11/12/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This case has been assigned to a new examiner since the previous examiner assigned to the case left the office.
2. This office action is in response to an After Final amendment filed May 6, 2004. The amendment has been entered. Claims 1-127, 132, 133, 141-144 and 147-231 were previously pending, with claims 1-127 and 147-231 withdrawn from consideration. Applicants cancelled claim 132. Claims 1-127, 133, 141-144 and 147-231 are pending, with claims 1-127 and 147-231 withdrawn from consideration.
3. Applicants' cancellation of claim 132 overcame the rejection of this claim under 35 U.S.C. 112, first paragraph, enablement.
4. This office action is made non-final because of new grounds for rejection for claim 133.

#### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on August 13, 2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
6. The information disclosure statement (IDS) submitted on November 12, 2002 was filed after the mailing date of the first office action on February 28, 2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1637

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 133 is rejected under 35 U.S.C. 102(e) as being anticipated by Preuss et al. (U.S. Patent No. 6,156,953).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Preuss et al. teach a method of preparing a transgenic plant cell comprising contacting a starting plant cell with a recombinant DNA construct comprising a plant centromere, whereby said starting plant cell is transformed with said recombinant DNA construct, wherein the plant centromere is an *Arabidopsis thaliana* centromere, and wherein said starting plant cell is an *Arabidopsis thaliana* cell.

Preuss et al. teach preparing a transgenic plant cell by transforming plant cells (= starting plant cells) with artificial chromosomes (col. 4, lines 21-34; col. 24, lines 19-39). The artificial chromosomes are recombinant constructs comprising plant centromeres (Fig. 7A-7H; col. 3, lines 65-67; col. 4, lines 1-20). Preuss et al. teach *Arabidopsis thaliana* centromeres (col. 22, lines 14-25) and *Arabidopsis thaliana* host cells (col. 15, lines 11-13).

Art Unit: 1637

*Allowable Subject Matter*

9. Claims 141-144 are allowed with respect to SEQ ID NO: 4. No references were found teaching or suggesting a transgenic plant comprising a minichromosome vector comprising a nucleic acid sequence of SEQ ID NO: 4.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E Strzelecka whose telephone number is (571) 272-0789. The examiner can normally be reached on M-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TS  
May 20, 2004

  
JEFFREY FREDMAN  
PRIMARY EXAMINER  
5/24/04